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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,026	03/08/2001	Robert R. Champion	1912-001	4695

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MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER
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LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/802,026	<b>Applicant(s)</b> CHAMPION ET AL.	
	<b>Examiner</b> Jennifer Liversedge	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/802,026 filed on June 14, 2006.

The amendment contains previously presented claims: 1 and 3-15.

The following claim was canceled: 2

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5 and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No. US 2001/0042036 A1 to Sanders (further referred to as Sanders).

Regarding claim 1, Sanders discloses a computerized method (page 2, paragraph 23; page 9, paragraph 85) comprising the steps of:

associating each of one or more investment identifiers (page 1, paragraph 2; page 2, paragraph 23-24; page 3, paragraph 28 where individual contracts are

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established and directly correlated to the account opener) with an investment amount (page 2, paragraph 25; page 4, paragraph 48; page 7, paragraph 64; page 14, paragraph 120) and one or more asset category identifiers (page 1, paragraph 16; page 2, paragraph 23; page 7, paragraph 68; page 10, paragraph 93; page 14, paragraph 118); and

associating each of the one or more asset category identifiers with (a) a corresponding allocation parameter (page 1, paragraphs 2 and 16; page 4, paragraph 48; page 7, paragraphs 64 and 68; page 14, paragraph 120), and (b) a corresponding response parameter (page 1, paragraphs 1 and 16; page 2, paragraph 25; page 4, paragraphs 46 and 48; page 9, paragraph 84; page 11, paragraph 96);

wherein each of the respective investment identifiers uniquely specifies a corresponding investment contract (page 1, paragraph 2; page 2, paragraph 23-24; page 3, paragraph 28 where individual contracts are established and directly correlated to the account opener);

wherein each of respective asset category identifiers uniquely specifies an investment asset category (page 1, paragraph 16; page 2, paragraph 23; page 7, paragraph 68; page 10, paragraph 93; page 14, paragraph 118);

wherein the allocation parameter specifies an allocation amount to be indexed to the corresponding asset category identifier (page 1, paragraphs 2 and 16; page 4, paragraph 48; page 7, paragraphs 64 and 68; page 14, paragraph 120); and

wherein the response parameter specifies a relationship between (i) the allocation amount, and (ii) subsequent price, percentage return, and/or relative valuation

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changes in, and/or net worth changes relating to, the corresponding investment asset category (page 1, paragraphs 1 and 16; page 2, paragraph 25; page 4, paragraphs 46 and 48; page 9, paragraph 84; page 11, paragraph 96).

Regarding claim 3, Sanders discloses the computerized method further comprising the steps of receiving an input enabling a determination of the investment identifier (page 3, paragraphs 28 and 41), and at least one of:

(a) the investment amount (page 2, paragraph 25; page 4, paragraph 48; page 7, paragraph 64; page 14, paragraph 120);

(b) the one or more asset category identifiers (page 1, paragraph 16; page 2, paragraph 23; page 7, paragraph 68; page 10, paragraph 93; page 14, paragraph 118);

(c) the allocation parameter to be associated with each of the one or more asset category identifiers (page 1, paragraphs 2 and 16; page 4, paragraph 48; page 7, paragraphs 64 and 68; page 14, paragraph 120); and

(d) the response parameter to be associated with each of the one or more asset category identifiers (page 1, paragraphs 1 and 16; page 2, paragraph 25; page 4, paragraphs 46 and 48; page 9, paragraph 84; page 11, paragraph 96).

Regarding claim 4, Sanders discloses the computerized method wherein a computerized mechanism associates each of the one or more investment identifiers with the one or more corresponding asset category identifiers, and associates each of

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the one or more asset category response parameter, and wherein the input to the computing mechanism is received using at least one of:

(a) an electronic device coupled over the Internet to the computing mechanism; and (page 8, paragraph 73; page 9, paragraph 85);

(b) a telephonic device coupled over the PSTN (public switched telephone network) to an IVR (interactive voice response) system and/or a speech recognition system, wherein the IVR and/or speech recognition system is coupled to the computing mechanism.

Regarding claim 5, Sanders discloses the computerized method wherein the step of receiving an input includes receiving one or more templates corresponding to a given investment identifier, each of respective templates setting forth a corresponding predefined allocation parameter and a corresponding predefined response parameter for each of one or more asset category identifiers (page 13, paragraph 114).

Regarding claim 9, Sanders discloses the method wherein each of the one or more corresponding electronic investment contracts is held by a corresponding investor (page 1, paragraph 2; page 2, paragraph 23-24; page 3, paragraph 28 where individual contracts are established and directly correlated to the account opener).

Regarding claim 10, Sanders discloses the method further including the step of determining an overall monetary value for one or more of said corresponding electronic

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investment contracts (page 8, paragraphs 78-79; page 9, paragraphs 84-85; page 13, paragraph 114).

Regarding claim 11, Sanders discloses the method wherein each corresponding electronic investment contract defines a financial relationship between said corresponding investor and a contract administrator such that, upon demand, the contract administrator shall convey monetary value of the contract to said investor (page 8, paragraphs 78-79; page 9, paragraphs 84-85; page 13, paragraph 114).

Regarding claim 12, Sanders discloses the method further including the step of calculating an aggregate position for an asset category by consolidating allocation parameters and response parameters associated with said asset category (page 8, paragraphs 78-79; page 9, paragraphs 84-85; page 13, paragraph 114).

Regarding claim 13, Sanders discloses the method further including the step of calculating aggregate positions for each of a plurality of asset categories (page 8, paragraphs 78-79; page 9, paragraphs 84-85; page 13, paragraph 114).

Regarding claim 14, Sanders discloses the method further including the step of using the calculated aggregate positions to automatically generate purchase and/or sale orders for any of (a) futures contracts, (b) swaps, (c) contracts for differences, (d)

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securities, and (e) other financial instruments (page 8, paragraphs 78-79; page 9, paragraphs 84-85; page 11, paragraph 96; page 13, paragraph 114).

Regarding claim 15, Sanders discloses the method further including the step of using the calculated aggregate positions to generate purchase and/or sales orders so as to enable the contract administrator to hedge the payment obligation (page 6, paragraph 60; page 11, paragraphs 96 and 98).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders as applied to claim 5 above, and further in view of US Patent No. 6,622,130 B1 to Shepherd (further referred to as Shepherd).

Regarding claim 6, Sanders does not disclose the computerized method further including the step of receiving a template selection, wherein the template selection uniquely specifies one of the received templates corresponding to the given investment identifier; and the template so selected is then applied to an electronic investment contract associated with the given investment identifier.

However, Shepherd discloses the computerized method further including the step of receiving a template selection, wherein the template selection uniquely specifies one of the received templates corresponding to the given investment identifier; and the template so selected is then applied to an electronic investment contract associated with the given investment identifier (column 2, lines 30-39; column 5, lines 40-47).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic investment contract method as disclosed by Sanders to adapt the use of template selections as disclosed by Shepherd. The motivation would be to offer a variety of templates which could be used for different situations and circumstances based on investor profile and investment preferences and practices.

Regarding claim 7, Sanders does not disclose the computerized method further including the step of inputting a predefined condition to be associated with a specified

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one of the received templates, such that the specified one of the received templates is automatically applied to an electronic investment contract associated with the given investment identifier upon occurrence of the predefined condition.

However, Shepherd discloses the computerized method further including the step of inputting a predefined condition to be associated with a specified one of the received templates, such that the specified one of the received templates is automatically applied to an electronic investment contract associated with the given investment identifier upon occurrence of the predefined condition (column 2, lines 30-39; column 5, lines 40-47).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic investment contract method as disclosed by Sanders to adapt the use of automatically applied templates as disclosed by Shepherd. The motivation would be to apply the appropriate templates for different situations and circumstances based on investor profile and investment preferences and practices.

Regarding claim 8, Sanders does not disclose the computerized method wherein the predefined condition is at least one of:

- (a) an occurrence of: a specified price, percentage return, and/or relative valuation of, and/or change in net worth relating to, one or more investment asset categories;
- (b) an occurrence of a specified date and/or time; and
- (c) an occurrence of an event.

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However, Shepherd discloses the computerized method wherein the predefined condition is at least one of:

(a) an occurrence of: a specified price, percentage return, and/or relative valuation of, and/or change in net worth relating to, one or more investment asset categories;

(b) an occurrence of a specified date and/or time; and

(c) an occurrence of an event (column 2, lines 30-39; column 5, lines 40-47).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic investment contract method as disclosed by Sanders to adapt the use of template selection based on event occurrence as disclosed by Shepherd. The motivation would be to apply the appropriate templates for different events, situations and circumstances based on investor profile and investment preferences and practices.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 3-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600